



UNITED STATES PATENT AND TRADEMARK OFFICE

cen

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/822,669

04/13/2004

Se-young Jang

1572.1252

4799

21171 7590 01/22/2007
STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

DOAN, THERESA T

ART UNIT

PAPER NUMBER

2814

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
----------------------------------------	-----------	---------------

3 MONTHS

01/22/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/822,669

Applicant(s)

JANG ET AL.

Examiner

Theresa T. Doan

Art Unit

2814

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The Response to an Office Action filed 11/06/06 has being acknowledged and claims 1-4, 6-15 are pending in the application.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shi et al. (U.S. 6,746,896) in view of Admitted Prior Art (APA) as previously cited.

Regarding claim 1, Shi (Fig. 2) discloses a method of surface-mounting semiconductor chips on a PCB, including mounting a flip chip type semiconductor chip on the PCB comprising: forming a solder bump on a conductive contact area of each semiconductor chip on a back of a semiconductor wafer 100 mounted with a plurality of semiconductor chips (Fig. 2, column 5, lines 6-9); injecting underfill material on the area of the semiconductor wafer 100 formed with the solder bump 110 (Fig. 2, column 5, lines 9-16); hardening the underfill material partially to have a cohesive property (column 5, lines 15-16 and lines 33-67); severing the semiconductor wafer into the plurality of the semiconductor chips (column 5, lines 20-30); arranging the severed semiconductor chips having the hardened underfill material on the PCB (Fig. 2, column

Art Unit: 2814

5, lines 29-32); and heating the PCB at a predetermined temperature (column 5, lines 33-36).

Shi (Fig. 2) discloses a method of surface-mounting semiconductor chips on a PCB, including mounting a flip chip type semiconductor chip on the PCB, but fails to disclose a flip chip type semiconductor chip on the PCB mounted with electronic components.

However, APA (Fig. 2) shows that a PCB 400 is mounted with a semiconductor chip 200 and other electronic components 300 (see Background of the invention, paragraph [0007], lines 2-4) in a desired electronic application. Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to mount the flip chip type semiconductor chip of Shi on the PCB mounted with electronic components in order to electrically connect the semiconductor chip to the electronic components in a desired electronic application, as taught by APA.

Regarding claim 2, Shi discloses that the predetermined heating temperature is above the temperature of a melting point of the solder bump (column 6, lines 8-11).

Regarding claim 3, Shi (Fig. 2) discloses that the underfill material is solidified during the heating (column 5, lines 15-16 and column 6, lines 19-21).

4. Claims 4, 6-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shi et al. (U.S. 6,746,896) in view of Farnworth (U.S. 6,881,607) as previously cited.

Regarding claim 4, Shi (Fig. 2) discloses a process of preparing a wafer to be used for surface mounting a semiconductor chip on a PCB comprising: forming a plurality of solder balls 110 on a surface of a semiconductor wafer 100 (Fig. 2, column 5, lines 6-9); coating the surface of the semiconductor wafer formed with the solder balls 110 with underfill material (column 5, lines 9-16); curing the underfill material (column 5, lines 33-67) wherein a temperature to cure the underfill material to a semisolid state is lower than a reflow temperature of the solder balls (column 6, lines 8-11).

Shi does not disclose a step of curing the underfill material to achieve a semisolid state.

However, Farnworth (Figs. 9-11) teaches a method for underfilling and encapsulating flip-chip configured semiconductor device mounted on a carrier substrate to form semisolid dam structure of photopolymeric material to entrap liquid (see Abstract) by using the laser light beam 112 to cure liquid resin 60 to at least a semisolid state (column 14, lines 42-45). Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the process of Shi by performing a step of curing the underfill material to achieve a semisolid state because such curing the underfill material would provide a void-free dielectric underfill structure, as taught by Farnworth (column 5, lines 26-29).

Art Unit: 2814

Regarding claim 6, Shi (Fig. 2) discloses further comprising: severing the semiconductor wafer into the plurality of the semiconductor chips (column 5, lines 20-30); arranging the plurality of semiconductor chips on the PCB (column 5, lines 29-32); and raising the temperature of the PCB to a predetermined temperature (column 5, lines 33-36).

Regarding claims 7 and 12, Shi discloses that the predetermined temperature is above the reflow temperature of the solder balls (column 6, lines 8-11).

Regarding claim 8, Shi discloses that the underfill is cured to a solid state at the predetermined temperature (column 5, lines 15-16).

Regarding claim 9, Shi discloses that the height of the underfill coating is approximately equal to the height of the solder balls (see Fig. 2).

Regarding claim 10, Farnworth (Fig. 11) discloses that the height of the underfill coating 60 is above the height of the solder balls 30.

Regarding claims 11-14, Shi (Fig. 2) discloses a process of surface mounting flip chip type semiconductor chips on a PCB comprising: forming a plurality of solder bumps 110 on a surface of a flip chip type semiconductor wafer (column 5, lines 6-9); injecting the surface of the flip chip type semiconductor wafer 100 formed with solder bumps 110 with underfill material to a height approximately equal to the solder bumps (Fig. 2, column 5, lines 9-19); curing the underfill material (column 5, lines 33-67); severing the flip chip type semiconductor wafer 100 into a plurality of flip chip semiconductor chips (column 5, lines 20-30); arranging the plurality of flip chip semiconductor chips on the PCB (Fig. 2, column 5, lines 29-32); and raising the temperature of the PCB to a predetermined temperature (column 5, lines 33-34).

Shi does not disclose a step of curing the underfill material to achieve a semisolid state.

However, Farnworth (Figs. 9-11) teaches a method for underfilling and encapsulating flip-chip configured semiconductor device mounted on a carrier substrate to form semisolid dam structure of photopolymeric material to entrap liquid (see Abstract) by using the laser light beam 112 to cure liquid resin 60 to at least a semisolid state (column 14, lines 42-45). Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the process of Shi by performing a step of curing the underfill material to achieve a semisolid state because such curing the underfill material would provide a void-free dielectric underfill structure, as taught by Farnworth (column 5, lines 26-29).

Response to Arguments

Applicant's arguments with respect to claims 1-4 and 6-14 have been considered.

5. Applicant argues that Shi does not disclose the process as claimed because Shi teaches a process requiring the use of carrying film to transfer the semiconductor chip in the middle of the manufacturing process.

This argument is not persuasive because of the following reasons:

First, Applicant cannot read limitations only set forth in the description into the claims for the purpose of avoiding the prior art. *In re Sporck*, 386 F.2d 924, 155 USPQ 687 (CCPA 1967). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ 2d 1057 (Fed. Cir. 1993). It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. *Constant V. Advanced Micro-Devices Inc.*, 7 USPQ 2d 1064. The Examiner thus regards that the Applicant misinterprets the principle that claims are interpreted in the light of the specification.

Second, it should be noted that it has long been held that the use of the term "comprising" leaves a claim open for inclusion of materials or steps other than those recited in the claims. *Ex parte Davis*, 80 USPQ 448 (PTO Bd. App. 1948). Use of the term "comprising" does not exclude the presence of other elements. *In re Hunter*, 288 F.2d 930, 129 USPQ 25 (CCPA 1961). Therefore, a process step requiring the use of carrying film to transfer the semiconductor chip is not excluded.

Art Unit: 2814

6. Applicant argues that the examiner's conclusion of obviousness is based upon improper hindsight reasoning.

This argument is not persuasive because it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, the motivation of the electrically connecting the semiconductor chip to the electronic components (as taught by Fig. 2 of APA) would motivate one of skilled in the art to combine the references as suggested.

7. Applicant also argues that it would not be obvious to combine the applied references because none of the applied references teach or suggest coating the surface of the semiconductor wafer with underfill material and curing the underfill material to achieve a semisolid state.

This argument is not persuasive because of the following reasons:

First, in contrary to Applicant's assertion, Farnworth (Fig. 10) clearly discloses the steps of coating the surface of the semiconductor wafer 20 with underfill material 60 and curing the underfill material 60 to achieve a semisolid state (column 14, lines 41-44). And,

Art Unit: 2814

Second, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation of providing a void-free dielectric underfill structure by curing the underfill material to semisolid state (as taught by Farnworth, column 5, lines 26-29) would motivate one skilled in the art to combine the references as suggested.

The rest of applicant's arguments have been addressed and considered in the rejections shown above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theresa T. Doan whose telephone number is (571) 272-1704. The examiner can normally be reached on Monday to Friday from 7:00AM - 3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WAEL FAHMY can be reached on (571) 272-1705. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2814

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Theresa Doan", with a stylized flourish at the end.

Theresa Doan
January 17, 2007.